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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,848	11/29/2000	Yoon Kean Wong	PALM-3529.US.P	1951

7590 08/23/2006
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EXAMINER

LAO, LUN YI

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,848

Applicant(s)

WONG, YOON KEAN

Examiner

LUN-YI LAO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/15/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-7, 11-12, 15, 16, 18, 20, 28-29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated Will(5,477,508).

As to claims 1, 3-7, 11-12, 15-16, 18, 20, 28-29 and 31, Will teaches a personal digital assistant jog dial application access and activation system comprising a display(2 or 23) for displaying a listing of applications(TIME, ALARM; STOPWATCH; CALCULATOR; etc)(see figures 1 and 9a) ; a central processor(20); a RAM(21); a ROM(22) and a jog dial(3 or 25, 26 or 36 or 43)(see figures 1-3a, 6a-7b, 12b; column 5, lines 30-55; column 6, lines 22-38 and column 7, lines 28-65).

As to claims 4-5, 11-12, 15, 16, 18, 20, 28-29 and 31, Will teaches the selection of the items(e.g. ALARM) is carried out by highlighting indicator on the display when the jog dial(3 or 36 or 43) is rotated and the activation occurs when the jog dial(3 or 36 or 43) is depressed after the selection is made(see figures 1, 6b, 7a, 12b; column 5, lines 33-46 and column 7, lines 29-65).

As to claims 6 and 16, Will teaches that the highlight indicator moves up the application list when the jog dial is rotated up and moves down the application list when the jog dial is rotated down (see figures 1, 6b, 7a; column 5, lines 33-46).

As to claims 7, 18 and 31, Will teaches a cancel indicator(175) that cancel the access. When the jog dial is depressed(see figures 1, 6a-7a, 11f and column 11, lines 29-35).

As to claim 9, Will teaches that the application is activated when the jog dial is depressed a specified number of times (see figures 1, 6a-7a; abstract; column 4, lines 36-50 and column 7, lines 28-65).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oh(6,771,250) in view of Kato(6,297,795).

As to claim 1-32, Oh teaches a personal digital assistant jog dial application access and activation system (10) that includes, a display (50) for displaying an image

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including listing of applications (120-135)(see figures 1-2, 4 and column 4, lines 13-20), a central processor (60) for processing the information, a memory (70) for storing information and instruction for the central processor(60), and a Jog dial (40) for accessing and activating an application and coupled to data bus(see figures 1-4; column 3, lines 22-45 and column 4, lines 1-23).

Oh teaches a memory(70). Oh fails to a memory having RAM and ROM.

Kato et al teach a jog dial application access system comprising a display(11) for displaying a listing of applications(see figure 9) ; a central processor(20); a RAM(23); a ROM(24 or 25) and a jog dial(12)(see figures 1-5, 9-11; column 9, lines 64-68; column 10, lines 1-33 and lines 59-67; and column 11, lines 1-25). It would have been obvious to have modified Oh with the teaching of Kato et al, so the changeable programs could store in an RAM to allow a writing operation and reading operation at low cost, small size, low electric power consumption and high-speed access, the non-changeable programs could stored in an ROM to simplify the circuit configuration of a system and provide better data retention and longer life.

As to claims 4, 11, 12, 14-20 and 28-32, Oh teaches the selection of the items(110) is carried out by highlighting indicator on the display when the jog dial(40) is rotated(see figures 1-2, 4 and column 4, lines 14-20).

As to claims 4, 11, 12, 14-20 and 28-32, Kato et al teach the selection of the items is carried out by highlighting indicator on the display when the jog dial(12) is rotated(see figures 1, 9-12 and column 11, lines 1-25).

As to claim 5, Kato et al teaches depressing (clicking) the jog dial to activate the system (see figures 1, 9; column 8, lines 61-68; column 9, lines 1-6; column 11, lines 13-25).

As to claims 6 and 16, Oh teaches that the highlight indicator moves up the application list when the jog dial(40) is rotated up and moves down the application list when the jog dial is rotated down (see figures 1-2, 4 and column 4, lines 14-20).

As to claims 7-8 and 31-32, Oh teaches an cancel or off indicator for turning the device off(see figures 1, 4 and column 4, lines 13-25).

As to claim 9, Kato et al teach that the application is activated when the jog dial is depressed a specified number of times (see figures 1, 9-12 and column 11, lines 13-25).

As to claims 2 and 13, Kato et al teach the jog dial(12) accesses the application when depressed longer than a specific duration of time(see figures 1; column 9, lines 27-32 and column 10, lines 53-58).

As to claims 10, 14 and 21-23, Oh teaches the jog dial application activation system having application icons and titles(see figure 4).

As to claims 24 and 31, Oh teaches a user manipulates the input component for a specified period to make the operating system function list appear(see figure 5 and column 4, lines 38-56).

Response to Arguments

5. Applicant's arguments filed on June 12, 2006 have been fully considered but they are not persuasive.

Applicant argues that Will does not teach a personal digital assistant jog dial application access and activation system on page 10. Where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. See Bell Communications, 55 F.3d at 620; Kropa v. Robie, 187 F.2d 150, 88 USPQ 478, 481(CCPA 1951). Will's digital system can be called as a personal digital assistant jog dial application access and activation system since Will teaches all the limitation cited in claim 1(see paragraph #2 above).

Applicant argues that Will does not teach the application list includes a cancel indicator for canceling the access when the jog dial is depressed on page 11. The examiner disagrees with that since Will teach application list includes a cancel indicator for canceling the access(e.g. canceling accessing a record) when the jog dial is depressed o(see figures 1, 6a-7a, 11f and column 11, lines 29-35).

Applicant argues that the Will does not teach the presentation of the application list occurs while an application is active on page 11. The examiner disagrees with that since Will teach the presentation of the application list(6-10 or 57-61) occurs while an application is active(ALARM OR SET TIME is highlighted or blinking or selected)(see figures 1, 6b, 7a; 9A; column 5, lines 33-46 and column 7, lines 29-65).

Applicant argues that Will does not teach presentation of the operating function list occurs while another operating system function is already being performed on page 11. The examiner disagrees with that since Will teaches presentation of the operating function list(235) occurs while another operating system function(237 or clock function) is already being performed(see figure 12b and column 12, lines 22-30).

Applicant argues that Oh does not teach a jog dial for accessing and activating one of the applicants and the jog dial coupled to the data bus on page 12. The examiner disagrees with that since Oh teach a jog dial(a rotary switch 40) for accessing and activating one of the applicants(e.g. 125-130)(see figures 1-2, 4; column 3, lines 22-45 and column 4, lines 1-23) and the jog dial(40) coupled to the data bus(the jog dial, display, data bus all connected to each other, so that the jog dial(40) can activated the display data and data on a PDA)(see figures 1-3; column 3, lines 21-68 and column 4, lines 1-12).

Applicant argue that Kato et al does not teach a jog dial for accessing and activating applications on pages 12-13. The examiner disagrees with that since Kato et al teach a jog dial(12) for accessing and activating applications(for selecting applications(e.g. Web pages, a Phone Book, an Address Book, a calendar or schedules)(see figures 1-2, 4(a)-4(f) and column 8, lines 35-65).

Applicant argues that Oh does not teach the application list includes a cancel indicator for canceling the access when the jog dial is depressed on page 11. The examiner disagrees with that since Oh teach application list includes a cancel indicator(power off item) for canceling the access(see figures 1, 4 and column 4, lines

13-25). On the other hand, Kato et al teach a cancel indicator(e.g. Wrap Off or Beep off, Dial beep off) for canceling the access when the jog dial is depressed(see figures 12-13, 18; column 13, lines 15-20 and column 14, lines 57-62).

Applicant argues that the Oh does not teach the presentation of the application list occurs while an application is active on page 13. The examiner disagrees with that since Oh teach the presentation of the application list(125-135) occurs while an application is active(an application is in a blink item)(see figure 4 and column 4, lines 13-23).

Applicant argues that Oh does not teach presentation of the operating function list occurs while another operating system function is already being performed on page 14. The examiner disagrees with that since Oh teaches presentation of the operating function list(100; e.g. power off item or a sleep mode item; etc) occurs while another operating system function(launcher program 72) is already being performed(see figure 4 and column 4, lines 13-26).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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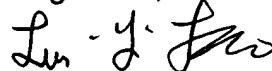
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lun-yi Lao whose telephone number is 571-272-7671. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 18, 2006



Lun-yi Lao

Primary Examiner